

REMARKS

Applicants express their appreciation to the examiner for reconsidering the application.

The undersigned thanks Examiner Flynn for checking the completeness of the Office's file and subsequently inviting the undersigned to resubmit the June 27, 2003 papers by fax, which was done September 30, 2003.

Information Disclosure Statements

As a further note regarding completeness, please note that the undersigned has not yet received acknowledgement that the IDS filed June 27, 2003 (and again on September 30, 2003) has been considered.

Also, the undersigned has not yet received acknowledgement that the IDS filed on December 3, 2002 has been considered. That IDS listed a single reference: U.S. Patent Application No. 20020176117 to Randalli et al., serial no. 226899 filed January 8, 1999. As noted in the IDS, the correct spelling may well be "Ranalli" rather than "Randalli"; see WO 00/41383.

Combination of References for Obviousness Rejection

In the Final Office Action, paragraph 6 on pages 19-20 acknowledges the legal requirement for a suggestion or motivation in the art to support a combination of references under Section 103. But the Final Office Action provides no such evidence. Applicants maintain their contention that the Section 103 rejections are improper for lack of such evidence, and will argue the matter on appeal should that become necessary.

Compliance with Rule 111

In the Final Office Action, paragraph 7 on page 20 asserts that the arguments of the response filed June 27, 2003 (and again on September 30, 2003) do not comply with 37 C.F.R. § 1.111(b). However, Rule 111 requires that applicant's reply be a writing "which specifically and distinctly points out the supposed errors in the examiner's action". This was done, by pointing

out the lack of evidence legally required for rejections under Section 103, and by challenging some instances of official notice.

The undersigned respectfully submits that the language in Rule 111 calling on applicants to specifically point out distinctions between the claims and the references is directed at situations where a response presents nothing more than a general allegation of patentability. That was not the situation presented by applicants' response, because the response contained a detailed legal argument (as yet unrebutted) against all of the rejections, and it also challenged official notices. Applicants' concise response was a *bona fide* attempt to advance the examination, and to do so efficiently. If a reference combination is improper, then all uses of that combination in claim rejections are improper regardless of their particularities. An analogous situation occurs commonly during patent examination, when an applicant and an examiner focus on a reason to allow an independent claim and do not spend time and money on unnecessary analysis of claims that depend from the allowable claim.

Official Notices

In the Final Office Action, paragraph 8 on page 20 essentially asserts that the burden regarding official notice is on applicants rather than on the examiner. The Final Office Action refers (without a full citation) to M.P.E.P. § 2144.03(C), and also points to the *Chevenard* case for support of its position that the burden is on applicants rather than the examiner. However, the examiner misinterprets the M.P.E.P. and *Chevenard*, and errs in asserting that the official notice statements are now admitted prior art. They are not admitted prior art, because the examiner has not followed the required procedure to have them admitted as prior art.

The first major step of the procedure laid out in M.P.E.P. § 2144.03 is summarized in the heading of subsection A: "Determine When It Is Appropriate To Take Official Notice Without Documentary Evidence To Support The Examiner's Conclusion". As stated in subsection A, "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration as being well-known**" (emphasis added). The challenged official notices do not meet this requirement. For example, if the use of a web

address as an addressing index which corresponds to a telecommunications number is indeed capable of “instant and unquestionable demonstration” as being well-known, one would expect the Office to provide such a demonstration when asked, instead of resisting the request as it has done. Applicants submit that this allegedly well-known teaching is actually not capable of instant and unquestionable demonstration as being well-known. Indeed, the Office admitted that this teaching is not found in the cited patents; *see* the 1/7/2003 office action at page 11. Other challenged instances of official notice are likewise not capable of instant and unquestionable demonstration.

The next major step of the official notice procedure is summarized in the heading of subsection B: “If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the **Technical Line Of Reasoning** Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable” (emphasis added). This was not done. No technical line of reasoning was provided. The notices merely contend that the desired information would have been obvious; *see* the 1/7/2003 office action. But M.P.E.P. § 2144.03(B) clearly states that “Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge.” Even in the *Chevenard* case cited by the Final Office Action there was nothing in the record to indicate the contrary and the applicant never demanded that the examiner produce evidence to support his statement. *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943). In the present situation, by contrast, applicants have consistently asked the examiners to produce supporting evidence if they can do so, and the examiner’s admissions that the noticed teachings are not found in the cited patents is contrary to taking notice in that it suggests the prior art was headed in a different direction than the claimed invention. “The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” M.P.E.P. § 2144.03(B). This has not been done.

Now we reach subsection C, whose first sentence is asserted in the Final Office Action as a basis for providing no evidence to support the challenged official notices. The subsection heading states: “If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence”. Applicants have indeed challenged the listed assertions as not properly

officially noticed and not properly based upon common knowledge. But in response, instead of supporting the findings with adequate evidence as required by the M.P.E.P. and the case law, the Office has in effect challenged applicants' challenge.

In particular, the examiner alleges that the first sentence of M.P.E.P. § 2144.03(C) is a basis for treating the challenged notices as admissions. This sentence reads: "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." But what does "such a finding" refer to in this sentence? In context within the M.P.E.P., it clearly refers to the "specific factual findings predicated on sound technical and scientific reasoning" from three sentences earlier, in subsection B. The Office has provided no such finding. If and when such a finding is provided, then applicants will indeed have the burden of adequately traversing it if they continue to challenge the official notices.

But the examiner cannot simply leap over the Office's intervening obligations. The examiner must determine that the noticed information is "capable of instant and unquestionable demonstration as being well-known", and the examiner must "provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge". Only then does the burden shift to applicants to traverse that finding. Accordingly, applicants maintain their challenge to the official notices.

Support for Claim Amendments

The amendments are supported, for example, in the application at page 9 lines 17-19 (examples: "1234567", "123-4567", "123-456-7890"), page 10 lines 2-3 (examples: "@1234567", "@1234567890"), page 18 lines 11-16 (example: "username@5551111"), page 33 lines 6-7 (examples: "1234567", "123-4567", "123-456-7890", "+011-1-123-4567").

Claims Compared with Art

The Final Office Action acknowledges on page 2 that Agraharam "fails to disclose a telecommunications number being used in place of at least a conventional domain name." For

that teaching, the rejections rely on Low. But Low fails to teach the limited domain names that are now expressly claimed. In fact, Low teaches away from them. As amended, the claimed invention requires destination domain names that are free of periods. But the discussion in columns 7, 8, and 15-20 of Low not only fails to teach destination domain names that are free of periods, it also teaches away from such names by devoting considerable and detailed attention to the perceived problem of how to insert periods (a.k.a. "dots") into domain names:

Consideration will next be given to the parsing of a telephone number into a domain name--in other words, where to insert the "." characters into the number to provide the structuring of a domain name. Of course, as already explained, telephone numbers are hierarchically structured according to each country's numbering plan. Thus one approach would be to follow this numbering plan structuring in dividing up a telephone number to form a domain name. By way of example, the telephone number "441447456987" which is a UK number (country code "44") with a four digit area code ("1447") and six digit local number ("456987") could be divided to form a domain name of 456987.1447.44 (note that the reversal of label order occasioned by the fact that the DNS labels are arranged least significant first). If the telname space is a subdomain of the DNS with a placement as illustrated in FIG. 12B, the fully qualified domain name derived from the telephone number would be:

456987.1447.44.tel.itu.int.

There are however, difficulties inherent with trying to match the numbering plan hierarchy when parsing a telephone number into a host name. Firstly, in order to parse an international number correctly, it would be necessary for each entity tasked with this operation to know the structuring of each country's numbering plan and where, as in the UK, area codes may be of differing length the required knowledge may need to take the form of a lookup table. Whilst this is not a complicated computational task, it is a major administrative nuisance as it means that each country will need to inform all others about its numbering plan and any updates. The second problem is that a six or seven digit local number is a very large domain; it would be preferable to create subdomains for performance and scaling reasons but there is no obvious way of doing this.

These problems can be overcome by giving up the restriction that the parsing of telephone number into a domain name should match the structuring of national numbering plans. In fact, there is no strong reason to follow such a scheme as DNS servers know nothing about the meaning of the name space. It is therefore possible to parse telephone numbers using a deterministic algorithm taking, for example, 4 digits at a time to limit the size of each subdomain and making it possible to 'insert the dots' without knowing the numbering plan concerned. So long as the DNS domains and zones

served by the DNS servers are created correctly it will all work.

For international numbers it would still seem appropriate to separate off the country codes and so a hybrid parsing scheme would be to parse the initial part of a dialled number according to known country codes and thereafter use a deterministic scheme (for example 3,7 or 4,6 or 3,3,4) to separate the digits. Of course, if a fragmented telname space is being used as illustrated in Figure UC then the country code is used to look up the host name tail and it is only the national part of the number which would be parsed.

Low, U.S. Patent No. 6,466,570 at column 19 lines 13-65

Accordingly, applicants submit that the claims are allowable even if the references are combined.

Conclusion

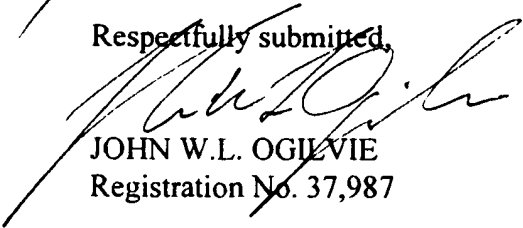
In light of the above, applicants respectfully submit that the application is in condition for allowance. Applicants' silence here as to any point does not signify agreement or acquiescence in the Office's assertions, and they reserve all arguments.

Check no. 17467 for \$860.00 (\$385.00 + \$475.00) is enclosed as payment for the Request for Continued Examination, under Rules 114 and 17(e), and for a 3-month extension of time (small entity). The Commissioner is authorized to charge any additional fee or to credit any overpayment in connection with this paper to Deposit Account No. 20-0100.

If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call John Ogilvie at 801-566-6633 so that such matters may be resolved as expeditiously as possible.

DATED this 25th day of May, 2004.

Respectfully submitted,



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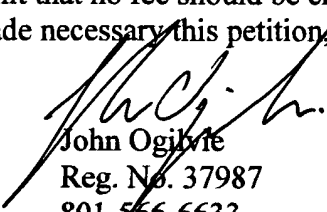
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Patent Application No. 09/521,152 filed 03/08/2000
Attachment to Petition for Revival Under 37 CFR 1.137(b)

The abandonment was unintentional because a response to the Office Action of 09 December 2003 was timely filed. A Request for Continued Examination (RCE Submission) and a 3-month extension of time petition, with a check for \$860, were filed May 25, 2004. Copies of these documents, and a copy of the USPTO-date-stamped postcard acknowledging them, are enclosed.

Although the Office is authorized to charge the fee for this petition (small entity) to Deposit Account 20-0100, we respectfully submit that no fee should be charged because the error leading to the abandonment, which made necessary this petition, was an error within the Office.


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